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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,987	08/22/2001	Richard A. Demmin	JHT-0002	4456

7590 03/07/2006

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EXAMINER

BULLOCK, IN SUK C

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/869,987	DEMMIN ET AL.	
	Examiner	Art Unit	
	In Suk Bullock	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/2/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on December 2, 2005 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,582,590.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to a similar process utilizing an identical bulk metal catalyst having the defined composition. See particularly claims 1 and 2 of the instant application and claims 1, and 8-10 of Patent '590.

The claims of instant application are directed to "hydrofining oil feedstock" whereas the claims in Patent '590 are directed to "hydroprocessing." However, the respective processes are considered synonymous because they include treating a similar feed with hydrogen at comparable process conditions.

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,712,955.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to a similar process utilizing an identical bulk metal catalyst having the defined composition.

The claims of instant application are directed to "hydrofining oil feedstock" whereas the claims in Patent '955 are directed to "hydroprocessing." However, the respective processes are considered synonymous because they include treating a similar feed with hydrogen at comparable process conditions.

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,755,963.

Although the conflicting claims are not identical, they are not patentably distinct from

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each other because they are both directed to a similar process utilizing a similar bulk metal catalyst comprising at least one non-noble Group VIII metal and at least two Group VIB metal.

Patent '963 fails to disclose the identical formula with the same molar ratios of various components as recited in the instant application.

It would have been obvious to one having ordinary skill in the art to have modified the catalyst composition of Patent '963 by determining the most effective combination of metal components from Group VIB and Group VIII to obtain desired results.

With respect to molar ratios, it would have been obvious to one having ordinary skill in the art to have selected the portion of Patent '963 that corresponds to the claimed range. It is within the level of a skilled artisan to have determined the optimum molar ratios of each metal component.

The claims of instant application are directed to "hydrofining oil feedstock" whereas the claims in Patent '963 are directed to "hydrotreating." However, the respective processes are considered synonymous because they include treating a similar feed with hydrogen at comparable process conditions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0203228B1 (hereinafter EP '228) or U.S. Patent 3,619,414 (hereinafter Patent '414) or U.S. Patent 5,841,013 (hereinafter Patent '013).

EP '672 discloses a process for hydrotreating hydrocarbon oils employing a catalyst system arranged in stacked bed comprising an upper zone containing up to 10%w of Group VIII metal compound and 3-15%w of Group VIB metal compound, and a lower zone containing up to 10%w of Group VIII metal components and from 3-30%w of

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Group VIB metal components. In both zones the catalyst comprises a nickel and a molybdenum and/or tungsten component. See page 3, lines 31-45; page 4, lines 31-47; and page 5, lines 8-18. The process conditions disclosed (page 6, Table 1) read upon the claimed process conditions.

Patent '414 discloses a process for catalytic hydrofinishing of petroleum distillate in the presence of a catalyst comprising oxides of 4-16 wt% of molybdenum and a combination of about 10-25 wt% of nickel and tungsten. The process conditions disclosed read upon the claimed process conditions. See Abstract; col. 2, lines 22-42; and col. 3, line 56 to col. 4, line 23.

Patent '013 discloses aromatics hydrogenation process in the presence of a catalyst comprising a mixed metal oxide catalyst of the formula $ML(Mo_yW_{1-y}O_b)_a$ wherein M is Cr and/or one or more divalent promoter metals selected from the group consisting of Mn, Fe, Co, Ni, Cu, and Zn; L is one or more ligands; and $0 \leq y \leq 1$. See Abstract; col. 1, lines 35-62; and col. 5, lines 15-22. The process conditions disclosed (col. 5, lines 29-35) read upon the claimed process conditions.

None of the above references disclose the claimed molar ratio of the catalyst components.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the applied prior art above by determining the optimum value of a cause effective variable such as molar ratio of the catalyst components through routine experimentation.

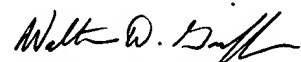
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to In Suk Bullock whose telephone number is 571-272-5954. The examiner can normally be reached on Monday - Friday 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

I.B.


Walter D. Griffin
Primary Examiner